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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/070,826 | 06/03/2002 | Brian Wilson | 687-104 | 9545 |

23117 7590 04/22/2005

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| EXAMINER |
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CHANG, VICTOR S

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| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,826

Applicant(s)

WILSON ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-25 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,6-11,13,14,16 and 18-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3,12,15 and 17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' remarks filed on 3/8/2005 and 10/25/2004. Applicants' amendments to the specification, claims 1 and 15, cancellation of claim 5, and new claim 26 have been entered.
2. In response to an Office action dated 12/8/2004, in a telephone interview on 3/4/2005, and also in the reply dated 3/8/2005, Applicants argue that "moieties containing ketone groups are encompassed by the definition of moiety 1, wherein the definition of Ar includes the moieties (i)* and (i) as depicted on page 4 of the amendment dated October 25, 2004. It was for this reason that claim 5 was indicated to read on the elected species." (Remarks, 3/8/2005, page 2). The Examiner repeats (see Office action dated 12/8/2004, page 2) that such an amendment clearly directs the scope of the invention to non-elected species which contains a moiety II (see Office action dated 1/7/2004, and Response filed 2/9/2004). While original claim 5 does show Ar as having a ketone moiety in claim 1, clearly such a recitation is a duplicate of non-elected moiety II. Further, it should be noted that claim 5 was withdrawn as non-elected species. In other words, the Examiner asserts that canceling a non-elected species and incorporating a non-elected element into independent claim 1 is improper and non-responsive. Additionally, upon reconsideration, the Examiner notes that the specification also appears to be not enabled for the ketone moieties of Ar recited in claim 1, because the Examiner is not able to find express disclosure or inherent

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teaching regarding how these ketone moieties are incorporated into the instant invention. Clarification of support in the specification is requested.

3. Because of the duplication in structural moieties, as set forth above, the Examiner notes that further election/restriction requirement is required as follows, so as to avoid any further confusion on the elected scope of the invention.

Election/Restrictions

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species for Ar in claim 1 are as follows:

Species A(Ar) for (i)*.

Species B(Ar) for (i).

Species C(Ar) for (ii).

Species D(Ar) for (iii).

Species E(Ar) for (iv).

Species F(Ar) for (v).

Species G(Ar) for (vi).

Species H(Ar) for (vii).

Species I(Ar) for (viii).

Species J(Ar) for (ix).

Species K(Ar) for (x).

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. It should be noted that Species which duplicates previously non-elected species, such as a ketone moiety, constitutes a non-responsive election. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each of the species are structurally distinct, and are patentable over each other.

5. In view of the restriction requirement, the rejections over EP 0 932 213 in view of JP 06-029032 in the prior Office action dated 6/24/2004 is withdrawn for now, and to be reinstated in the next Office action when Applicants' response to election requirement is completed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
Art Unit 1771

4/19/2005